

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No. : 10/719,224
Inventor(s) : Janet K. O'Grady *et al.*
Filed : November 21, 2003
Art Unit : 1616
Examiner : Ernst V. Arnold
Docket No. : T-733
Confirmation No. : 3177
Customer No. : 27752
Title : Topical Cosmetic Composition

CORRECTED APPEAL BRIEF

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P. O. Box 1450
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The attached Corrected Appeal Brief is a response to A Non-Compliant Appeal Brief mailed on February 19, 2009. This Brief is filed pursuant to the appeal from the decision communicated in the Final Rejection mailed on April 16, 2007 and the Advisory Action mailed on June 27, 2007.

A timely Notice of Appeal was filed on July 9, 2007.

REAL PARTY IN INTEREST

The real party in interest is The Procter & Gamble Company of Cincinnati, Ohio.

RELATED APPEALS AND INTERFERENCES

There are no known related appeals, interferences, or judicial proceedings.

STATUS OF CLAIMS

Claims 1-6 and 11-32 are currently pending in the application, of which claims 1-6 and 22-32 stand rejected and claims 11-21 are currently withdrawn due to a Restriction Requirement. Claims 7-10 have been canceled without prejudice.

Claims 1-6 and 24-32 are appealed. Claims 22-23 were not addressed by the Final Rejection mailed April 16, 2007.

A complete copy of the appealed claims is set forth in the Claims Appendix attached herein.

STATUS OF AMENDMENTS

The Advisory Action indicates that for purposes of appeal, the proposed amendments will not be entered. Appellants note however that no claim amendments were presented in response to the Final Rejection mailed April 16, 2007. Claim amendments were submitted in response to the Office Action mailed May 23, 2006, and these are reflected in the appealed claims located in the Claims Appendix.

SUMMARY OF CLAIMED SUBJECT MATTER

The claimed subject matter is directed to a variety of topical cosmetic compositions comprising a specific combination of vitamin A, vitamin E, aloe, and at least one member selected from the group consisting of bisabolol, panthenol, vitamin B₃ and vitamin C.

The subject matter of independent claim 1 is as follows: A topical cosmetic composition for providing noticeably healthy looking human skin comprising a topical cosmetic carrier vehicle (*see, e.g.*, from page 2, line 12 to page 3, line 11) including vitamin A (*see, e.g.*, page 1, line 18 and page 3, lines 13 and 23-26), vitamin E (*see, e.g.*, page 1, line 18; page 3, line 13; and page 4, lines 8-10), aloe (*see, e.g.*, page 1, line 18; page 3, line 13; and page 4, lines 18-19), and at least one member selected from the group consisting of bisabolol (*see, e.g.*, page 1, line 20; page 3, line 15; and page 4, lines 16-17), panthenol (*see, e.g.*, page 1, line 20; page 3, line 15; and page 4, lines 11-15), vitamin B₃ (*see, e.g.*, page 1, line 21; page 3, line 15; and page 3, line 27 to page 4, line 3) and

vitamin C (*see, e.g.*, page 1, line 20; page 3, line 15; and page 4, lines 4-7), wherein said vitamin A, said vitamin E, said aloe, and said at least one member are each independently included in an amount of about 0.001% to about 5% by weight of the composition (*see, e.g.*, page 3, lines 12-18), wherein the topical cosmetic composition is in the form of a shaving gel (*see, e.g.*, page 2, lines 3-4 and Examples 1-2 on pages 5-6) and further comprises a lathering agent (*see, e.g.*, page 2, lines 18-21), a foaming agent (*see, e.g.*, page 2, line 28 to page 3, line 1), and/or a self-foaming agent (*see, e.g.*, page 2, line 28 to page 3, line 1).

The subject matter of independent claim 24 is as follows: An array of topical cosmetic compositions for combined application to human skin (*see, e.g.*, page 2, lines 2-4; page 4, lines 25-28; and Examples 1-6 spanning pages 5-8), the array comprising: a) a first topical cosmetic composition in accordance with claim 1 (*see above*); and b) a second topical cosmetic composition selected from the group consisting of an aftershave gel (*see, e.g.*, page 4, lines 25-28 and Example 3 on page 6), a moisturizing lotion (*see, e.g.*, page 4, lines 25-28 and Example 4 on page 7), a cleansing wash (*see, e.g.*, page 4, lines 25-28 and Example 5 on page 7), and a cleansing bar (*see, e.g.*, page 4, lines 25-28 and Example 6 on page 8), wherein the second topical cosmetic composition comprises vitamin A, vitamin E, aloe, bisabolol, panthenol, vitamin B₃ and/or vitamin C (*see Examples 3-6 on pages 6-8*).

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

Rejection of claims 24-32 under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement.

Rejection of claims 1-6 and 24-32 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Stoner *et al.* (U.S. Patent No. 5,902,574) in view of Fike (U.S. Patent No. 5,612,382) and Lisboa *et al.* (U.S. Patent No. 5,679,324).

There were no arguments presented by the Office Action related to claims 22-23. As such, there are no arguments presented below addressing these claims.

ARGUMENTS

I. Rejection of claims 24-32 under 35 U.S.C. § 112, first paragraph

A. *In Haec Verba* Support For Claimed Subject Matter Is Not Required Under 35 U.S.C. § 112, First Paragraph

Claims 24-32 are directed to an array of topical cosmetic compositions for combined application to human skin, the array comprising: a) a first topical cosmetic composition in accordance with claim 1; and b) a second topical cosmetic composition selected from the group consisting of an aftershave gel, a moisturizing lotion, a cleansing wash, and a cleansing bar, wherein the second topical cosmetic composition comprises vitamin A, vitamin E, aloe, bisabolol, panthenol, vitamin B₃ and/or vitamin C.

In the Final Rejection, mailed April 16, 2007, the Examiner rejected these claims under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement. The Examiner stated that “Claims 24-32 introduces new matter as the claims recite[s] the limitation ‘array.’ There is no support in the specification for this term.” The Federal Circuit has concluded that “the disclosure as originally filed does not . . . have to provide *in haec verba* support for the claimed subject matter at issue” and instead that “the patent specification must describe an invention in sufficient detail that one skilled in the art can clearly conclude that the inventor invented what is claimed” to fulfill the written description requirement.¹ Thus, the fact that the term “array” is not present in the specification is not a proper basis, by itself, to reject a claim under 35 U.S.C. § 112, first paragraph.

B. The Skilled Artisan Could Clearly Conclude By Reading The As-Filed Specification That The Inventor Was In Possession Of The Subject Matter Recited in Claims 24-32

The as-filed specification, in paragraph [0015] on page 4, states that “one could apply two different compositions within the scope of the present invention (e.g., a shaving gel and an aftershave lotion) during each day rather than two applications of the same composition.” Appellants first note that the genus of “two different compositions” is not

limited to the combination of a shaving gel and an aftershave lotion since the qualifier “e.g.” was explicitly employed at the end of this disclosure. The genus of “two different compositions” is instead defined by the phrase “within the scope of the present invention.” To determine the scope of two different compositions within the scope of the present invention, the skilled artisan could simply read the entire specification, aspects of which are described below.

The written description provides for 16 different product forms, stating that “the topical cosmetic composition of the present invention may be in the form of a liquid, lotion, cream, gel (including non-aerosol, aerosol, and self-foaming gel), foam, mousse, spray (aerosol or pump), paste or solid (e.g., stick or bar). . . . a solution, such as an aqueous or alcoholic or hydroalcoholic solution, or an emulsion, including both a water-in-oil emulsion and an oil-in-water emulsion” (see paragraph [0004] on page 2). Following this extremely broad product form disclosure, the written description provides a lengthy list of suitable carrier vehicles and additional ingredients—the skilled artisan could clearly take the explicit product form list and ingredient list and create a “large group of things,” as the Examiner has interpreted the term “array.” Furthermore, the application provides 6 different composition examples directed to a wide variety of different product types that includes 2 significantly different shaving compositions, an after-shave composition, a moisturizing lotion, a cleansing wash, and a cleansing bar. In view of this expansive disclosure, Appellants submit that the skilled artisan could clearly conclude by reading the as-filed specification that the inventor was in possession of the subject matter recited in claims 24-32.

II. The Rejection of claims 1-6 and 24-32 under 35 U.S.C. § 103(a)

The Applied References Fail To Teach Or Suggest The Specific Combination Of Skin Care Components In The Manner Claimed

Claims 1-6 and 24-32 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Stoner et al. (U.S. Patent No. 5,902,574; hereinafter “Stoner”) in view

¹ *Cordis Corp. v. Medtronic AVE, Inc.*, 339 F.3d 1352, 1364 (Fed. Cir. 2003).

of Fike (U.S. 5,612,382; hereinafter “Fike”) and Lisboa et al. (U.S. Patent No. 5,679,324; hereinafter “Lisboa”).

Appellants submit that one of the requirements of a *prima facie* case of obviousness—that the references when combined must teach or suggest all the claim limitations in the manner claimed—however has not been met. The “suggestion or motivation” criterion has recently been addressed by the Supreme Court in *KSR Int’l Co. v. Teleflex*.² “While the *KSR* Court rejected a rigid application of the teaching, suggestion, or motivation (“TSM”) test in an obviousness inquiry, the Court acknowledged the importance of identifying ‘a reason that would have prompted a person of ordinary skill in the relevant field to combined the elements in the way the claimed new invention does’ in an obviousness determination.”³ The *KSR* Court also indicated that as long as the TSM test is not applied as a “rigid and mandatory” formula, the TSM test can provide “helpful insight” to an obviousness inquiry.⁴

Independent claims 1 and 24 each recites, *inter alia*, a shave gel comprising a topical cosmetic carrier vehicle including vitamin A, vitamin E, aloe, and at least one member selected from the group consisting of bisabolol, panthenol, vitamin B₃ and vitamin C. Thus, the claims require a very specific combination of vitamin A, vitamin E and aloe, along with an additional material(s) selected from another specific list of bisabolol, panthenol, vitamin B₃ and vitamin C. The applied references do not teach or suggest the specific combination of ingredients in the manner claimed. And with reference to the Supreme Court’s *KSR* opinion, there is no apparent reason flowing from the applied references why a person of ordinary skill in the art of developing shave gels would have combined the prior art elements in the manner claimed.

In the Final Rejection, mailed April 16, 2007, the Examiner stated that “[i]t is *prima facie* obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be used for the very same purpose.” Appellants submit however, that the applied references appear to have distinct purposes, as discussed more fully below.

² 127 S. Ct. 1727 (2007).

³ *Takeda Chemical Industries, Ltd. v. Alphapharm Pty., Ltd.*, 2007 U.S. App. Lexis 15349 at *12-13 (Fed. Cir. June 28, 2007).

Stoner discloses shaving preparations that employ a reducing agent to soften the protein structure of hair. Stoner also discloses a long list of optional additives, but is silent regarding any combinations or mixtures, much less the specifically claimed combination (*see* col. 5, lines 33-53). Vitamin A, vitamin E, and aloe are included in the long list of optional additives, but their combination (even two-way combination) is nowhere to be found. Furthermore, the examples are silent with regard to two of these three optional additives.

Fike discloses a pharmaceutical composition for transdermally delivering pharmaceutically active ingredients through skin or mucosal tissues (*see e.g.*, the Abstract). The pharmaceutical composition may contain vitamin B₃. Fike does not teach or suggest combining vitamin B₃ with any other vitamin or additive—certainly not the combination of vitamin A, vitamin E, and aloe.

Lisboa discloses aerosol foamable fragrance compositions. Lisboa discloses employment of bisabolol, but fails to teach or suggest its combination with a base mixture of vitamin A, vitamin E, and aloe. It is far from clear how the Lisboa compositions are to be used. The Background section discusses aerosol shaving compositions that are well known in the art, but it also discusses personal care foam products other than shaving compositions (*see* column 1, lines 32-44). The remaining portions of the specification are silent regarding shaving compositions. Furthermore, the disclosure following the examples states that “[t]he compositions can provide a quick breaking foam which has an effective, long-lasting cooling sensation to the skin, low or zero noticeable stinging to the skin, including cut or irritated skin, and long-lasting smooth, moisturized skin feel” (*see* column 9, lines 42-46)—suggesting the compositions are to be used after shaving with a separate shaving composition.

Thus, in view of the above discussion, none of the applied references teach or suggest a shave gel comprising a topical cosmetic carrier vehicle including vitamin A, vitamin E, aloe, and at least one member selected from the group consisting of bisabolol, panthenol, vitamin B₃ and vitamin C. And there is no apparent reason flowing from their respective disclosures why a person of ordinary skill in the art of developing shave gels would have combined the prior art elements in the manner claimed.

⁴ KSR, 127 S. Ct. at 1731.

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SUMMARY

In view of all of the above, it is respectfully submitted that the Section 112 and Section 103 rejections of record should be withdrawn.

Respectfully submitted,
THE PROCTER & GAMBLE COMPANY



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Date: May 19, 2009
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CLAIMS APPENDIX

1. (Rejected) A topical cosmetic composition for providing noticeably healthy looking human skin comprising a topical cosmetic carrier vehicle including vitamin A, vitamin E, aloe, and at least one member selected from the group consisting of bisabolol, panthenol, vitamin B₃ and vitamin C, wherein said vitamin A, said vitamin E, said aloe, and said at least one member are each independently included in an amount of about 0.001% to about 5% by weight of the composition,
wherein the topical cosmetic composition is in the form of a shaving gel and further comprises a lathering agent, a foaming agent, and/or a self-foaming agent.
2. (Rejected) The composition of claim 1 comprising at least two members selected from the group consisting of bisabolol, panthenol, vitamin B₃ and vitamin C.
3. (Rejected) The composition of claim 1 comprising vitamin B₃.
4. (Rejected) The composition of claim 1 or 3 comprising vitamin C.
5. (Rejected) The composition of claim 2 comprising bisabolol and vitamin B₃.
6. (Rejected) The composition of claim 5 comprising vitamin C.
7. - 10. (Cancelled)
11. - 21. (Withdrawn)
22. (Rejected) The composition of claim 1 wherein the topical cosmetic composition comprises a foaming agent or a self-foaming agent.
23. (Rejected) The composition of claim 1 further comprising a propellant.
24. (Rejected) An array of topical cosmetic compositions for combined application to human skin, the array comprising:
 - a) a first topical cosmetic composition in accordance with claim 1; and

b) a second topical cosmetic composition selected from the group consisting of an aftershave gel, a moisturizing lotion, a cleansing wash, and a cleansing bar, wherein the second topical cosmetic composition comprises vitamin A, vitamin E, aloe, bisabolol, panthenol, vitamin B₃ and/or vitamin C.

25. (Rejected) The array of claim 24 wherein the first topical cosmetic composition further comprises a propellant.

26. (Rejected) The array of claim 24 wherein the second topical cosmetic composition comprises vitamin A and vitamin E.

27. (Rejected) The array of claim 24 wherein the second topical cosmetic composition comprises vitamin A, vitamin E, aloe, and at least one member selected from the group consisting of bisabolol, panthenol, vitamin B₃ and vitamin C.

28. (Rejected) The array of claim 24 wherein the second topical cosmetic composition comprises at least two members selected from the group consisting of bisabolol, panthenol, vitamin B₃ and vitamin C.

29. (Rejected) The array of claim 24 wherein the second topical cosmetic composition comprises vitamin B₃.

30. (Rejected) The array of claim 24 wherein the second topical cosmetic composition comprises vitamin B₃ and vitamin C.

31. (Rejected) The array of claim 24 wherein the second topical cosmetic composition comprises bisabolol and vitamin B₃.

32. (Rejected) The array of claim 31 wherein the second topical cosmetic composition further comprises vitamin C.

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EVIDENCE APPENDIX

None.

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RELATED PROCEEDINGS APPENDIX

None.